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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Appellant(s): Klug

James L. Johnson
For Appellant

29 SEP 1995

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellant's reply brief on appeal filed August 10, 1995.

(1) *Status of claims.*

The statement of the status of claims contained in the brief is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

(4) *Issues.*

The appellant's statement of the issues in the brief is correct.

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(5) *Grouping of claims.*

Appellant's brief includes a statement that claims 1-8, 23, and 25-28 stand or fall together as a group, and that claims 9-11, 13-15, and 17 stand or fall together as a group.

Appellant's brief includes a statement that claims 1 and 9 do not stand or fall together and provides reasons as set forth in 37 C.F.R. § 1.192(c)(5) and (c)(6).

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U.S. Pat. No. 5,300,943 to Jakobs et al.

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

Claims 1-11, 13-15, 17-23, and 25-26 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Pat. No. 5,300,943 to Jakobs et al. ("Jakobs").

With respect to claim 1, Jakobs taught the invention substantially as claimed including the computer file editing system for a plurality of users at different remote locations, comprising the:

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- plurality of personal computers, one for each user (col.6, line 55), each including computer file display means (col.4, lines 9-11);
- interconnecting means for electrically interconnecting the host computer with the others of the plurality of personal computers to permit transmission of electrical signals corresponding with the file editing operations therebetween (col.9, lines 17-22);
- wherein the plurality of users are permitted to concurrently view the given computer file (col.6, lines 58-60) and, subject to practical system limitations, said computer file display means, multi-tasking processing means, and interconnecting means operate so that said file editing operations and said corresponding limited data transfer to the display means occur on a substantially real-time basis relative to said edit inputs to permit the plurality of users at said different remote locations to view the edits made to the given computer file substantially contemporaneously with the corresponding input of said edits and execution of said file editing operations (col.6, lines 58-62).

Jakobs did not teach the use of personal computers as the workstations of their system, and while Jakobs's Background of the Invention may appear to actually teach away from implementing the system using personal computers, it only did so up to the time of their invention (October 3, 1986). By the time of the present invention (August 23, 1989), the capabilities of personal computers had long surpassed those of the personal computers of Jakobs's time, and one of ordinary skill in the art would have recognized that contrary teachings of Jakobs's Background of the Invention were no longer applicable. Therefore, it would have been obvious to one of ordinary skill in the art to implement Jakobs's system using personal computers because of their popularity (col.1, lines 24-25), and because doing so would improve the system by permitting an embodiment which used common, and relatively low-cost components.

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Jakobs did not specifically teach that at least one of the personal computers was to be designated the host computer for given file editing operations, and having multi-tasking processing means for coordinating the execution of said file editing comprising edits of less than the entire file inputted by at least one of the users, and for coordinating the transfer of data corresponding with, and limited to, the file editing operations from the host computer to the display means of the others of the plurality of personal computers whereby the file editing operations and corresponding limited data transfer are performed in a predetermined manner by the host computer.

Since Jakobs merely taught that their workstation was to be used in a distributed conferencing and editing system (col.6, lines 55-56), but did not discuss how the workstations were to be interconnected, it must be assumed that Jakobs intended the artisan to rely on what was known in the prior art at the time the art to implement the workstation of Jakobs in a distributed conferencing and editing system.

At the time of the present invention, distributed networks were commonly implemented using a personal computer based on the Intel 80386 microprocessor running network software (e.g. Novell NetWare 386 version 3.0), i.e., a multi-tasking personal computer acting as the host). It would have been obvious to one of ordinary skill in the art at the time of the invention to practice the distributed conferencing and editing system of Jakobs with at least one personal computer, designated the host computer for given file editing operations, and having multi-tasking processing means for coordinating the execution of said file editing, and for coordinating the transfer of data corresponding with, and limited to, the file editing operations from the host computer to the display means of the others of the plurality of personal computers whereby the file editing operations and corresponding limited data transfer are performed in a predetermined manner by the host

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computer because of the benefits gained by the system of Jakobs in being able to take advantage of using common and well-known local area networking methods as was implicitly suggested by Jakobs. Further, Jakobs suggested the arrangement where one workstation was controlled by another workstation (col.16, lines 21-23).

Jakobs did not explicitly teach that editing comprised edits of less than the entire file, but since Jakobs did teach that "changes made to the image made at one workstation [are] instantly viewed by the users at all workstations" (col.6, lines 61-62), Jakobs implicitly taught that the editing comprised edits of less than an entire file because if editing were done to an entire file before transfer to the other users, it would not be possible for the other users to instantly view the changes.

Claim 9 is essentially the same as claim 1 except for the additional limitation, which was taught by Jakobs (col.9, lines 7-15), that the designated host computer is interconnected with an input means. Claim 9 would have been obvious for the same reasons as set forth for claim 1 and is, therefore, rejected for the same reasons as set forth for claim 1.

Claim 23 is essentially the same as claim 1 except for the additional limitation, which was taught by Jakobs (col.6, line 66-col.7, line 6), that all users are in voice communication during a given editing operation. Claim 23 would have been obvious for the same reasons as set forth for claim 1 and is, therefore, rejected for the same reasons as set forth for claim 1.

Claim 11 is essentially the same as claim 9 except for the additional limitation (as asserted by Appellant in the discussion of claim 11 at p.31 of Appellant's brief) that requires that the users be in voice communication.

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Jakobs did not teach that the users were required to be in voice communication, but neither does claim 11. Claim 11 merely specifies, and Jakobs taught (col.8, line 54-col.9, line 6), that the voice communications means is for transmitting audio signals representative of any user's voice to each other user. Therefore, claim 11 would have been obvious for the same reasons as set forth for claim 9 and is, therefore, rejected for the same reasons as set forth for claim 9.

(10) *New Grounds of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

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(11) *Response to argument.*

The Appellant, in traversing the Examiner's statement that Jakobs "appear[ed] to actually teach away from implementing the system using personal computers," cited numerous passages from Jakobs illustrating that Jakobs considered prior art workstations to be unsuitable for practicing the Jakobs invention, thereby "more than 'appear[ing]' to teach away from Appellant's invention." Appellant's Reply Brief, pages 5-7.

The Appellant further argues that Jakobs taught a combination of displays, but the Examiner did not "identify a personal computer which could implement the invention disclosed by Jakobs (e.g., multiple resolutions)," therefore, there exists no motivation to "utilize the teachings of Jakobs in the context of a personal computer-based computer file editing system." Appellant's Reply Brief, pages 9-10.

With respect to these arguments, Appellant fails to address the nature of Jakobs' teachings away from the instant invention. The passages of Jakobs cited by Appellant are all discussions of the shortcomings of workstations existing at the time of Jakobs. Persons of ordinary skill in the art at the time of the instant invention, however, would immediately realized that those shortcomings were no longer applicable. Therefore, as was stated in the rejection, it would have been obvious to one of ordinary skill in the art to implement Jakobs's system using personal computers because of their popularity (col.1, lines 24-25), and because doing so would improve the system by permitting an embodiment which used common, and relatively low-cost components.

Further, Jakobs only appeared to teach away from personal computers, due to the blurring of the distinction between workstations and personal computers which had occurred by the time of the invention. In fact, Jakobs only taught away from the single display workstations of the prior art. Jakobs taught, as a substitute, a new workstation

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with multiple displays and the various functions of the instant invention. The differences between Jakobs' workstation and the workstations of the prior art were tied to the differences in the displays. There was no indication that the main CPU's were different. Therefore, just as it was obvious to substitute a personal computer for the main CPU in a workstation because doing so would improve the system by permitting an embodiment which used common, and relatively low-cost components, so would it have been obvious to substitute a personal computer for the main CPU in the workstation of Jakobs.

The Appellant argues, with respect to claim 1, that Jakobs did not teach the use of a host personal computer with a multifunctional multi-tasking processing means which both coordinates the execution of file editing operations input by at least one of a plurality of users, and the transfer of data from the multi-tasking personal computer to all of the plurality of personal computers within the file editing system.

With respect to this argument, since, as indicated in the previous rejection, Jakobs taught each of these features with the exception of the use of personal computers, the essence of the Appellant's argument is the Jakobs did not teach the use of personal computers, and was addressed above.

The Appellant further argues, with respect to claim 1, that because Jakobs "provides minimal disclosure on how two or more of the workstations described therein may be interconnected, Jakobs clearly did not disclose the manner in which Appellant's system is set up with a host personal computer. Appellant's Reply Brief, page 16.

With respect to this argument, since Jakobs claimed the interconnection of multiple workstations through a common communications channel, Jakobs, claims 7, 10, 11, and since Jakobs "provides minimal disclosure on how two or more of the workstations described therein may be interconnected," the statutory presumption of validity, 35 U.S.C.

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282, requires the interpretation of Jakobs' minimal disclosure to mean that Jakobs was relying on what was old and well-known in the art for enablement of these claims.

Therefore, since it would have been obvious to implement the teachings of Jakobs with personal computers, and since, as indicated in the previous rejection, distributed networks, such as in Jakobs, were commonly implemented using a personal computer based on the Intel 80386 microprocessor running network software (e.g. Novell NetWare 386 version 3.0), i.e., a multi-tasking personal computer acting as the host, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the system of Jakobs with a personal computer based on the Intel 80386 microprocessor running network software (e.g. Novell NetWare 386 version 3.0), i.e., with a multi-tasking personal computer acting as the host, because of the benefits gained by the system of Jakobs in being able to take advantage of using common and well-known local area networking methods as was implicitly suggested by Jakobs.

The Appellant further argues, with respect to claim 1, that the editing operations of Jakobs is different than in the instant invention in that edits made at a first workstation are performed at a first CPU, and a second CPU receives a transmittal from the first CPU which causes the edits to be performed at the second workstation.

With respect to this argument, Jakobs' teaching is not contrary to the provisions of claim 1, which merely specifies that one or more ("at least one") hosts coordinates the transfer of data corresponding with and limited to file editing operations from the host computer to the other personal computers.

The appellant argues, with respect to claim 9, that Jakobs did not teach that each personal computer had an input device which directly interfaced with the host computer.

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With respect to this argument, in the same sense that Appellant's invention claimed this feature, i.e., "[t]he CPU's of the remote PCs 12, 14 support the overall operation of the system so that in effect the peripherals of the remote PCs 12, 14 are linked directly to the input/output processor 28 and are under the control of the host PC 10," Specification page 20, Jakobs did teach that each personal computer had an input device which directly interfaced with the host computer (col.6, lines 55-65).

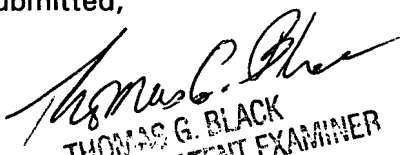
The appellant further argues, with respect to claim 9, that because Jakobs taught the integration of voice communications capabilities, the teaching that "[t]wo or more systems can link to allow fully-interactive real-time distributed conferencing and editing wherein dispersed users can work cooperatively on images viewed by all of them" (col.6, lines 55-58) "is by no means a disclosure that each participant in a collaborative editing process is able to actually enter edits as required by claim 1," suggesting that the passage could mean that one party makes edits in response to edits orally suggested by other participants via the integrated voice communications capabilities of the Jakobs workstation." Appellant's Reply Brief, pages 21-22.

With respect to this argument, Appellant's interpretation is incorrect as the necessity of one user to make edits and then orally instruct the other users to make the same edits is contrary to Jakobs teaching that the "changes to the image made at one workstation [are] **instantaneously** viewed by the users at all workstations." (emphasis added, col.6, lines 61-62).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

PYW
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